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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,216	05/18/1999	DAVID L. SILVERMAN	3432.80970	3594
22907	7590	07/12/2004	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/313,216	SILVERMAN ET AL.	
	<b>Examiner</b>	Art Unit	<i>My</i>
	Jan Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 May 2002.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 12-36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 12-36 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      Paper No(s)/Mail Date, \_\_\_\_ .  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_ .      5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

1. This is in response to the applicant's communication filed on May 14, 2002.

Claims 12-36 are currently pending in this application.

Claim 12 is amended.

Claims 29-36 have been added.

### *Response to Amendment*

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US 5,136, 501 or 5, 077,665) (hereinafter referred to as Silverman).

Silverman discloses a negotiated matching system and a method for displaying a user interface on at least one terminal in a negotiated matching system comprising six display regions (Figs. 1-20, Figs. 4-5, 13-18 have multiple display regions).

Silverman does not disclose a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a forth region for displaying a negotiation between said input, a fifth display region displaying a group of counter parties, a sixth display region displaying an input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

3. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley (US 4,677,552).

Sibley discloses a negotiated matching system and a method for displaying a user interface on at least one terminal in a negotiated matching system (trade exchange which transmits data representing bids and offers col. 1, lines 5-15) comprising six display regions (Fig. 9 ).

Sibley does not disclose a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a forth region for displaying a negotiation between said input, a fifth display region displaying a group of counter parties, a sixth display region displaying an

input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

4. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US 4,903,201 or 4,980,826).

Wagner discloses a negotiated matching system and a method for displaying a user interface on at least one terminal in a negotiated matching system comprising six display regions (futures trading exchange which compares any bid with offers, finds a match and completes transaction, col. 1, lines 5-14, user interface for trading system (Fig. 19).

Wagner does not disclose a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a forth region for displaying a negotiation between said input, a

fifth display region displaying a group of counter parties, a sixth display region displaying an input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

5. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiseman (5,168,446).

Wiseman discloses a negotiated matching system and a method for displaying a user interface on at least one terminal in a negotiated matching system comprising six display regions (system for processing transactions between commodity traders col. 2, lines 10-24, Fig. 7a-20B).

Wiseman does not disclose a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a forth region for displaying a negotiation between said input, a

fifth display region displaying a group of counter parties, a sixth display region displaying an input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

***In the alternative:***

6. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley, Jr (4,677,552) or Shavit et al (4,799156) or Wagner (4,903,210 or 4,980,826) or Silverman et al (5,077,665 or 5,136,501) or Wiseman (5,168,446) in view of Kosaka et al (5,267,148) or Guttermann et al (5,297,031) or Trojan et al. (5,297,032).

Sibley or Shavit or Wagner or Silverman or Wiseman disclose a method and system requiring a user to input data about offers to either buy or sell items. They do not disclose six display regions.

However, Kosaka (Fig. 10, col. 5, lines 45-61 (information Multi-window output), Guttermann (Figs. 2a-2d), and Trojan (Fig. 2, col. 5, lines 43-58) disclose displaying the information in regions.

It would have been obvious to one of ordinary skill in the art to incorporate into the disclosures of Sibley, Shavit, Wagner, Silverman, or Wiseman the teachings of Kosaka, Guttermann or Trojan to provide a display means that allows the trader to track the market, select securities, bid and ask pricing, market direction and market depth so as to provide more complete and copious knowledge about the market.

Neither Sibley, Shavit, Wagner, Silverman, Wiseman, Kosaki, Guttermann, or Trojan disclose a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a forth region for displaying a negotiation between said input, a fifth display region displaying a group of counter parties, a sixth display region displaying an input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 12-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-39 of U.S. Patent No. 5,924,082. Although the conflicting claims are not identical, they are not patentably distinct from each other because it appears that some display would be inherent or at least obvious in order to conduct a transaction including, negotiations, leaving the question of obviousness of a display portion for potential matches.

***Response to Arguments***

Applicant's arguments filed May 14, 2002 have been fully considered but they are not persuasive.

Claims 12-28 and 29-36 are directed to a negotiated matching system and method for displaying a user interface in a negotiated matching system which comprise a first and second display region for displaying values, a fourth display region for displaying a negotiation. As stated above in the claim analysis, the type data displayed on the displays is nonfunctional descriptive material. The data does not control the machine like software or a data structure, nor is there explicitly recited calculations dependent on the content of the data. See MPEP 2106 (a computer that differs from the prior art solely with respect to nonfunctional descriptive material cannot alter how the machine functions ....).

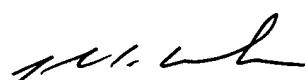
The applicant's invention is one requiring the presentation of information via a user interface. The display of information via a user interface is related to precedents dealing with printed matter – i.e., the presentation of information in a form that is useful and intelligible only to the human mind. See *In re Gulack*, 703 F. 2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) (“Where printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.”)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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